

REMARKS

Applicant has carefully reviewed the Office Action of August 16, 2004 and offers the following remarks to accompany the above amendments.

Initially, Applicant amends claims 1, 14, 26, 29-32, 43, and 46 to delete reference characters such as "a", "b", "c", "i", "ii", and the like. These amendments simplify the claims and are not intended to change the scope of the claims, nor are these amendments made for reasons relating to patentability. No new matter is added through these amendments.

Claim 17 duplicated claim 16, and claim 16 is herein canceled in light thereof. Claim 30 is amended to add a missing hyphen, delete a spurious semicolon, and add a missing period. Claims 6, 7, 18, and 19 are amended to change the erroneous placement of the hyphen in the phrase that should read "packet-switched telephone." These amendments are non-substantive amendments that do not affect the scope of the claims, nor are the amendments made for reasons relating to patentability.

Before addressing the rejections based on the references, Applicant provides a brief summary of the present invention and contrasts the present invention with Schuster so that the remarks are considered in the proper context. The present invention is directed to a server module that acts as a local intermediary for a local phone network and interfaces the local phone network to the broader phone network through the Internet. The server module allows someone without great technical training to configure the local phone network through a user friendly interface such as a web interface. In this manner, new phones may be added to the local phone network without specialized technicians having to perform a service call. The server module may be integrated into an internet protocol phone within the local phone network or associated with such an internet protocol phone. The internet protocol phones of the local phone network are provisioned from the server module via a first protocol.

In use, the server module registers using a SIP protocol (different from the first protocol) with a remote SIP proxy server and uses the server module's knowledge of the local phone network to register the internet protocol phones of the local phone network with the SIP proxy server. When a caller wishes to place a call from one of the internet protocol phones of the local phone network, the OFF-HOOK signal from the internet protocol phone initially goes to the server module, which in turn forwards the call set up request to the SIP proxy server and acts as

an intermediary between the SIP proxy server and the internet protocol phone until the call set up is completed.

In contrast, Schuster teaches a system whereby a personal information device (PID) such as a personal digital assistant (PDA) may be selectively connected to an Internet Protocol (IP) phone in a network. The PID may initiate a call through the IP phone, but more typically, the IP phone receives an incoming call for the user of the PID or phone. The IP phone checks the priority levels created by the PID user and compares the caller identification for the incoming call to the priority levels. If the incoming caller exceeds a certain threshold level, the call is passed through to the PID user. In this system, the IP phone does not control the PID, but merely acts as a conduit through which communication occurs.

Turning now to the substance of the Office Action, the Patent Office initially asserts that functional language preceded by phrases such as "adapted to" can not be a positive limitation and should not be given patentable weight. The Patent Office supports this assertion with a citation to *In re Hutchison*, 69 USPQ 138 (CCPA 1946). The Patent Office's reliance on *Hutchison* is misplaced. Applicant initially notes that in more recent decisions, the Federal Circuit has indicated that functional language such as that preceded by "adapted to" language cannot be disregarded. *Pac-Tec, Inc. v. Amerace Corp.*, 903 F.3d 796, 801 (Fed. Cir. 1990), *cert. denied*, 502 U.S. 808 (1991). Thus, modern courts have recognized that functional language preceded by "adapted to" can constitute a limitation. Applicant further notes that in the near sixty years since its decision, no court has ever followed *Hutchison*. The failure to follow *Hutchison* raises the question as to whether the pronouncements in *Hutchison* remain valid.

Even if *Pac-Tec* did not overturn *Hutchison sub-silencio*, *Hutchison* is distinguishable. First, *Hutchison* dealt with a precatory use within a preamble of an apparatus claim. The "adapted to" language used in the preamble discussed an ultimate application of the article and was not used to define the article itself. Put another way, the "adapted to" language in *Hutchison* defined a precatory use of the system by someone rather than the function of an element within the system. *Pac-Tec* clearly allows patentees to limit a claim through the use of functional language that describes the use of an element within the system.

Second, *Hutchison* suffered from definiteness issues by the use of "or the like." That is, the precise type of usage was not clear. By using "or the like," the language did not limit the usage of *Hutchison*'s laminate. In contrast, Applicant's functional language is recited in the

body of the claim (not the preamble), effectively limiting the function of the elements within the claim. Further, Applicant's language does not have definiteness issues associated therewith since Applicant does not use "or the like." In short, the *Hutchison* court was not rejecting the use of functional language or the use of the term "adapted to" in general, but simply stating that broad application in a preamble would not serve as a limitation in an article of manufacture claim.

Applicant further notes that there is no rule against defining the functionality of an element in a claim. In fact, the function of an element, especially an element such as a control system, may be the only true way to define an element in a definitive manner, as required by patent law. Means-plus-function claims rely solely on an element's functionality. Similarly, computer-related claims require the definition of functionality in order to separate a generic computer functioning in one way from a second computer functioning in another way. Clearly, defining and relying on function in a claim is far from improper, and is often required. Applicant requests that the functional language that follows "adapted to" in claims 1-5, 9, 12, 14-17, 21, 24, and 30-35 be given the weight to which it is entitled.

Claims 1-46 were rejected under 35 U.S.C. § 103 as being unpatentable over Schuster. Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show each and every claim element. MPEP § 2143.03. As noted above, the present invention relates to a server that controls multiple phones in a local phone network. Schuster, with or without modification, does not show the invention. If the Patent Office relies on a single reference and opines that it would be obvious to modify the reference to include a missing claim element, the Patent Office must do two things. First, the Patent Office must provide a motivation to make the modification, and second, the Patent Office must provide actual evidence to support the motivation to modify. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

As amended, the independent claims recite that the control system controls concurrent operation of the plurality of packet-switched telephones. The independent claims further recite that the server function registers with a remote proxy server and registers the packet-switched telephones with the remote proxy server such that they may operate concurrently. Support for this can be found in Figure 5, and page 14, lines 1-18. No new matter is added.

The Patent Office identifies the control system 604 of telephone 408 as the control system and indicates that PIDs 110, 210, 310, 410 are the plurality of packet-switched

telephones. The Patent Office then opines that it would be obvious to control multiple PIDs since there are multiple PID interfaces 610, 612, and 618 associated with the telephone 408.

While the telephone 408 does disclose multiple interfaces, there is no teaching or suggestion that multiple PIDs are used with the telephone 408 concurrently. A broad allegation to the contrary is insufficient to establish this claim element in an obviousness determination. Specifically, to modify a reference to include a missing claim, the Patent Office has to provide a motivation and evidence to support the motivation. *In re Kotzab*. While the Patent Office has indicated that there are three interfaces, this is not sufficient to provide a motivation to run three PIDs concurrently because there is no suggestion that such an operation would be advantageous.

Even if the concurrent operation is suggested, a point which Applicant does not concede, Schuster does not contemplate using the server function to register the PIDs with the remote proxy server. That is, while the PIDs may initiate a call through the telephone 408, the PIDs are not specifically registered with the SIP server 302. Only the telephone 408 is so registered. Furthermore, when an incoming call arrives at the telephone 408, the priority comparison takes place between the PID and the telephone 408, and does not require the registration of the PID with the SIP server 302. To this extent, Schuster does not teach the claim element recited in the independent claims. Since Schuster does not teach this claim element, Schuster does not establish *prima facie* obviousness. Applicant requests withdrawal of the § 103 rejection of claims 1-15 and 17-46 at this time on this basis.

Claims 11, 23, and 40 deserve special mention in that they have been amended to recite that the "control system is further adapted to receive, using the first protocol, an OFF-HOOK message from one of the plurality of packet-switched telephones and generate a message to the remote proxy server including identifying information for a device being called by the one of the plurality of packet-switched telephones." While Schuster's PID is described as potentially being a personal computer (PC) that has a phone function therein (Schuster, column 7, lines 42-47), there is no disclosure in Schuster that teaches or suggests the recited claim element. As such, this claim element is not taught or suggested by Schuster, and the Patent Office has not established obviousness. This provides an independent basis for the withdrawal of the § 103 rejection of claims 11, 23, and 40 at this time.

Applicant requests reconsideration of the rejection in light of the amendments and remarks presented herein. Schuster does not teach the local server function of the present invention. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:



Taylor M. Davenport
Registration No. 42,466
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

Date: December 15, 2004
Attorney Docket: 7000-052

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